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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,979	10/24/2003	William R. Campbell	042644-0303	1729
30542 7590 02/07/2007 FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			EXAMINER LEVY, NEIL S	
			ART UNIT	PAPER NUMBER
			1615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,979	<b>Applicant(s)</b> CAMPBELL ET AL.	
	<b>Examiner</b> NEIL LEVY	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 5, 16, 17, 23, 27, -31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15, 18-22, 24, -26, 32, 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/03/105</u> | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1615

### DETAILED ACTION

The multitude of submitted references were considered to the extent they would be considered in a standard examiner's key word search. Applicant's are requested to point out pertinent reference(s) to the claimed invention.

#### ***Election/Restrictions***

Applicant's election with traverse of species isopropyl myistate, human, lice and 5-methoprene in the reply filed on 11/06/06 is acknowledged. The traversal is on the ground(s) that The fatty acid esters have the same activity against ectoparasites, host identity is not pertinent. There is no basis to conclude the invention might work on one, not on another pest species, and the selection of added pesticide is not critical.

This is not found persuasive because The election requirement for esters is withdrawn, in consideration of applicant's argument they are all equally effective. The remaining requirement for election are maintained, as methods require different considerations and could result in different levels of efficacy, depending upon the host, pest and pesticide applied. Chemically different pesticides require different searches, while the host/pest methods require different evaluative criteria, such as treatment time, active agent concentrations, and host toxicity.

.The requirement is still deemed proper and is therefore made FINAL.

Claim5, 6, 17, 23, 27, 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected SPECIES, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/06/06

Claim29-31 STAND withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/06/06.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 1615

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4,6-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "alcohol free" is not evident to examiner as supported in the specification.

Claim8, 10, 11, 19, 21, 22, and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis. Claim 12 is to NO other lethal agent, while 24-26 adds methoprene-claim 19 is to THE siloxane. There are none in claim 1 or 12.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1615

Claim 12-15, 18, 20, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by DORN et al 6232328. DORN provides methods of killing ectoparasites on humans and animals (column 1, top) including lice (column 1, lines 27-29).

Alcohol free examples of topically applied formulations of fatty acid esters at 120%, 30% examples with an added pesticide. If it is not clear what mode of action is effective, but the methods of applying the same claimed formulations to kill any lice (thus head, body) species (column 6, line 33) are taught. (Column 6, line 62; column 7, line 30) with isopropyl myristate (column 8, top) and other fatty acid esters (column 8, lines 43-46; column 9, line 67; column 10, line 2) at 10-50%. Methoprene can be added (column 22, line 26).

Claim 12-14, 18, 19, 21, 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by GUITIERREZ US 2002/0044955.

See [0006] fleas, ticks, of animals, are killed by topical application of dimethicone (siloxane) and fatty acid esters (methylpalmitate) at greater than 10%, with an IGR, in an organic solvent. Solvents are not alcohol, rather include fatty acid esters [0021, 0022]. IGR is equivalently methoprene or S-methoprene [0025]. The devices used topically deliver the composition to the animal's coat [0036]. The instant cyclosiloxanes are generically found at [0021] as cyclomethicone.

Claim 1-4, 7, 12-15, 18, 32, 33 are rejected under 35 U.S.C. 102(a & e) as being anticipated by PEARLMAN 6303581

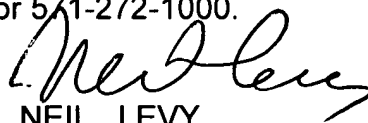
Non-toxic pediculocidal methods for killing head lice (column 5, top) followed by combing (column 7, lines 20-43) to remove nits are shown. Drying a presumed pediculostatic agent onto a louse (column 10) meets the instant claim 12 dehydration. Such include the instant fatty acid esters of stearate and palmitate (column 12, lines 29-33; column 13, top) at 10% or more, with silicones (column 12, lines 35-38). No alcohol is required (column 13, lines 8-20); fatty ester alone (neat) may be applied, or ethers, ketones, water can be used as solvents (column 13, lines 28-36.)

Art Unit: 1615

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
NEIL LEVY  
Primary Examiner  
Art Unit 1615